REMARKS

Claims 48-91 are pending in this application.   We appreciate the Examiner's comments that claims 84-89 are in condition for allowance, should the Section 101 rejections be withdrawn.

Restriction Requirement

The Examiner has made a restriction requirement and designated the following claim groups:

Group 1:   Claims 48-75 and 84-89.

Group 2:   Claims 76-83.

Group 3:   Claims 90 and 91.

Applicants affirm their election of Group 1 and do not object to restriction of group 1 from groups 2-3. Applicants reserve their right to object to restriction of group 3 from group 2, should the same restriction be imposed on a divisional application.

Interview Summary

Applicants appreciate the Examiner's courtesy of an interview on October 22, 2008. During the interview, we discussed section 101 and the references cited. We discussed how use of a communications network is referenced in the claims, which is tangible hardware sufficient to satisfy section 101. We discussed the references cited, beginning with Bryan and Olsen. This pair of references was discussed in an interview a year ago, at which time we agreed that the claims distinguished over Bryan and Olsen. During our recent interview, the Examiner did not disagree. We discussed Baker, which was cited six years ago and antedated by inventor declarations at that time. The Examiner commented that declarations are being scrutinized more carefully now than they were six years ago, so we provided the Examiner with material from the companion case 09/173,858, including hardcopy and a CD-ROM containing linked copies of documents of record in the companion case. More information regarding the newly submitted declarations appears below. That left for discussion only the Hogan reference.

The Hogan reference teaches a source code repository that stores "Repository Units." We focused on the definition in column 7, lines 28-34, which makes it clear that Hogan intentionally avoided specifying any structure for the Repository Units stored by

Hogan's technology. We pointed out to the Examiner had not referred, in the office action, the definition of Repository Unit and perhaps had overlooked it. In contrast, our claims describe a functional structure that controls the subsequent operation of other programs. The claimed functional structure finds no analog in Hogan. The Examiner did not disagree.

One area of agreement during the interview was that it would be nice to put this case in condition for allowance before the end of the year.

Rejection Under 35 U.S.C. § 101 of Claims 48-58, 70-75, and 84-89

The Examiner rejects **claims 48-58, 70-75, and 84-89** under 35 U.S.C. § 101, arguing that the claimed invention is directed to non-statutory subject matter. The Examiner reasons that these method claims "can be interpreted as programs." This is not a proper basis for rejection, as a method that involves communications via a network necessarily requires software to be running on hardware, which the Examiner advises (OA at 5, last paragraph) satisfies Section 101.

The Examiner does not apply his "can be interpreted as programs" argument to the wording of any of the claims. He writes, "Tangible hardware can be added to these independent claims in order to overcome the 35 USC 101 rejection." These methods are not detached from hardware and could not be performed entirely by mental steps, as the explicitly require use of tangible hardware. Claims 48 and 54 include the limitation, "providing … specifications … via a communiction network to a requesting node." The communication network is tangible hardware. Claim 70 includes the limitation, "publishing through a communication network a machine-readable specification." Again, the communication network is tangible hardware. Claim 84 includes the limitation, "receiving at the providing server via the network an input business document from the consuming server," and claim 89 describes the same event from the consuming server's perspective. Communication via the network between two servers utilizes tangible hardware. Therefore, each of the independent claims already include use of tangible hardware, as the Examiner say is enough to satisfy Section 101.

Applicants respectfully submit that the rejection of claims 48-58, 70-75, and 84-89 under § 101 should be withdrawn, which consequentially places claims 84-89 in condition for allowance.

Rejection Under 35 U.S.C. § 102(b) of Claims 48-75

The Examiner rejects **claims 48-75** under 35 U.S.C. § 102(b) as anticipated by each of four references:

[Bryan]: "Guidelines for using XML for Electronic Data Interchange"; Version 0.02; Editor: Martin Bryan, The SGML Centre: September 12, 1997.

Olsen et al. (WO 98/33125).

Baker et al. (U.S. Pat. No. 6,338,067).

Hogan et al. (U.S. Pat. No. 5,778,368).

Three of the four references can be dispensed with very succinctly.

For Bryan and Olsen, the undersigned and Examiner Coulter conducted an interview on October 15, 2007, that was memorialized in an interview summary on October 29, 2007 and in a response to office action on October 31, 2007. The <u>Examiner agreed that neither Baker nor Olsen reads on these claims</u>, for the reasons given in our summary and response. The Office Action of April 29, 2008 does not repudiate that agreement, dispute that the agreement was reached, or discuss the merits of why we agreed that the references do not read on the claims. The one sentence dismissal (OA at 16) of everything written in our response dated October 31, 2007 does not provide an adequate rationale to permit review on appeal or response by the Applicants. The Examiner has abandoned his position regarding Bryan and Olsen by admitting that they do not read on the claims and by failing to provide any response to the well reasoned positions of record.

For Baker, <u>previously submitted declarations that removed Baker as a reference</u>. The Examiner long ago acquiesced that declarations submitted on September 26, 2002 established a reduction to practice before March 18, 1998, which antedates Baker, thereby removing Baker as a reference.

For good measure, we submit additional hundreds of pages of declarations and corroborating exhibits that establish a reduction to practice before January 21, 1998, which is well before the Baker reference. In particular, the documents submitted include (1) five declarations of inventors and a non-inventor from whom historical files were obtained; (2) corroborating documents referred to in the declarations and in argument presented in the companion case; (3) a copy of the decision granting our petition for consideration on the merits of the declarations four out of the five inventors; and (4) our

response to office action electronically submitted on July 21, 2008 in the companion case, which explains appliance the evidence to the claims in that case. All of these documents also are found on the CD-ROM that we left with the Examiner during the interview, except that we have applied a caption to each document to associate it with this case.

Briefly, many pages of computer code and a variety of articles further corroborate the previously submitted declarations, which read directly on the language of these claims. The new declarations expressly say, in paragraphs 12-16 and elsewhere, that registries were actually reduced to practice before January 21, 1998, with abundant corroboration. This date of reduction to practice <u>removes both Baker and Olsen</u> as references.

It seems unmerited for the Examiner, without explanation, to have reasserted these three references, which he previously agreed were overcome by declarations and argument. Therefore, rejections based on the Bryan, Baker and Olsen references should be withdrawn.

In the following section, we respond to the new Hogan reference.

Rejection Under 35 U.S.C. § 102(e) of Claims 48-75

The Examiner rejects **claims 48-75** under 35 U.S.C. § 102(e) as anticipated by Hogan et al. (U.S. Pat. No. 5,778,368).

Preliminarily, Hogan is a source code repository with meta data attributes that enhance searching for reusable units of Real Time Embedded Software (RTES) program code. Hogan's repository stores "Repository Units", which are defined in col. 7, lines 28-34:

> Repository Unit: This is the smallest piece of information relating to embedded software stored in the *MXP* Repository. This component may be a Component, Framework, audio file, or a normal text or binary file or the real-time embedded software itself. A Repository Unit can also represent a collection of files with any combination of the above stated file types.

There is no specified structure to the data in Hogan's repository, because the objective of Hogan is to store whatever can usefully be stored. Hogan studiously avoided any teaching of content in the repository, presumably because Hogan did not want his invention to be limited by the actual contents of the repository or by how the contents of the repository were used after retrieval. Hogan is about finding RTES code and related

stuff, not about the structure of Repository Units or how their contents might control the operation of other software, after retrieval.

Viewing Hogan, it is important to keep in mind the "reference as a whole" rule, which derives from the wording of 35 U.S.C. section 103 ("subject matter as a whole"). The recent Federal Circuit case, *Net Moneyin, Inc. v. Verisign, Inc.*, App. No. 2007-1565, 2008 U.S. App. LEXIS 21827 (Fed. Cir. Oct. 20, 2008) (applying section 102), emphasizes looking at the reference as a whole, *id.*, at *23, in addition to considering the claim "as a whole." *See also, Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1563, 229 USPQ 561 (Fed. Cir. 1986) (both sections 102 and 103*); Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (applying section 103).

The as a whole requirement goes hand-in-hand with the "arranged as in the claim" requirement of section 102, as *Net Moneyin* explains:

> [O]ur precedent informs that the "arranged as in the claim" requirement applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a [*24] particular order. The test is thus more accurately understood to mean "arranged or combined in the same way as in the claim."
>
> For example, in *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984), we reviewed a district court's determination that a patent directed to a hydraulic scrap shearing machine was anticipated by a prior patent directed to a method for shearing spent nuclear fuel bundles. **Because the district court had "treated the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning," we reversed**. *Id.* at 1459. Although the prior art reference could be said to contain all of the elements of the claimed invention, it did not anticipate under 35 U.S.C. § 102 because it "disclose[d] an entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different material differently." *Id.* at 1458. **The reference thus was deficient because it did not disclose the elements of the claimed invention "arranged as in the claim" as required by 35 U.S.C. §102.** *Id.*

Moneyin, Inc., 2008 U.S. App. LEXIS 21827 at *23-24. The relationship among parts found in Hogan must be kept in mind and Hogan's decision, as a matter of definition, to avoid giving any structure to what that source code repository stored.

<u>Claim 48</u>

Claim 48 includes the limitations:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners; and

providing, in response to a request, one or more of the machine-readable specifications from said registry via a communication network to a requesting node

This claim is not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claim.

The Examiner is mistaken about what Hogan maintains in the repository. Hogan maintains "Repository Units", which are defined in col. 7. Some units may be audio files. Rather than giving structure to a Repository Units, Hogan teaches that they may be anything useful to store, either in text or binary format.

Hogan's teaching, taken as a whole, does not read on "machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners." To cobble together this specific structure, the Examiner resorts to unrelated phrases (OA at 11) from columns 7, 8, 10, 13 and 19. This resort to unrelated phrases ignores the part-to-part relationship taught by the reference and makes it clear that Hogan does not satisfy the stringent requirement for anticipation of finding all of the elements claimed arranged in the same manner as claimed.

Therefore, claim 48 should be allowable over Hogan et al.

<u>Claim 49</u>

Claim 49 includes the limitations:

said machine-readable specifications comprise data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units.

This claim is not anticipated by Hogan et al., because the reference does not include all

of the same elements arranged or combined in the same way as the claim.

The Examiner relies on col. 10, lines 54-67, which we reproduce below:

> **FIG. 2** illustrates a system level block diagram which
> 55 represents a logical hierarchy of inter-networked
> Repositories, i.e., storage areas, which contain Repository
> Units that are valuable to developers of RTES. The Reposi-
> tory Servers **7, 10,** and **12** are multi-user servers that provide
> access to reusable software to an internetworked user com-
> 60 munity. The Repository Servers **7, 10,** and **12** are accessed
> by Repository Clients **8** and **9** and Repository Station **11.**
> The Repository Clients **8** and **9** and Repository Station **11**
> access the appropriate Repository databases where the
> Repository Units meeting the requirements of a particular
> 65 search reside. Several Repository Clients and Repository
> Stations can simultaneously access a number of different
> Repositories.

This section of Hogan fails to teach "machine-readable specifications [that] comprise
data identifying respective descriptions of sets of storage units and logical structures for
the sets of storage units" arranged as a refinement of "machine-readable specifications
specifying business services offered by trading partners, the machine-readable
specifications including at least one of definitions of, and references to definitions of,
services offered and at least one of definitions of, and references to definitions of,
documents to be exchanged with such services by trading partners." Therefore, Hogan
does not meet the standard for an anticipation rejection, which requires finding all of the
same elements arranged in the same way as claimed.

Therefore, claim 49 should be allowable over Hogan et al.

Claim 50

Claim 50 includes the limitations:

machine-readable specifications included data adapted for parsing to identify
an input document and one or more transactions which accept said input
document

This claim is not anticipated by Hogan et al., because the reference does not include all

of the same elements arranged or combined in the same way as the claim.

The Examiner indiscriminately relies on the passage reproduced above plus passages from cols. 8 and 13. The discussion in col. 10 of distributing data across a hierarchically arranged group of repositories does not read on claim 50. The passage from col. 8 is irrelevant, because it merely describes distributed repositories, not the structure or functional significance of what the repositories store. The description of a search template cited from col. 13 is even less relevant to claim 50.

Therefore, claim 50 should be allowable over Hogan et al.

Claim 51

Claim 51 includes the limitations:

the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units

This claim is not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claim.

The Examiner repeats his reliance on the passage from col. 10 reproduced above, which does not teach that "the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units" arranged as a refinement of "machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners." Therefore, Hogan does not meet the standard for an anticipation rejection, which requires finding all of the same elements arranged in the same way as claimed

Therefore, claim 51 should be allowable over Hogan et al.

Claim 52

Claim 52 includes the limitations:

the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction

This claim is not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claim.

These limitations further define what came to be known as a Web services interface, a la, WSDL and WSI Basic Profile.

The Examiner relies on the same passages from cols. 8, 10 and 13 as he relied to reject claim 50, which are irrelevant for the same reasons given above, in the context of claim 50.

Therefore, claim 52 should be allowable over Hogan et al.

Claim 53, 56 and 57

Claims 53, 56 and 57 include limitations such as:

the storage units comprise parsed data

the storage units comprise unparsed data

These limitations claims are not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claims.

For both claims, the Examiner seems to be relying on the passages of cols. 8, 10 and 13 that we addressed above. Hogan does not discuss, in any of these passages, whether stored data is parsed or unparsed, in the context of "machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners." Reading the reference as a whole, it presents an entirely different invention that works in a different way with a different result.

Therefore, claims 53, 56 and 57 should be allowable over Hogan et al.

Claim 54

Claim 54 combines limitations of claims 53 (parsed data) and 48-49 (maintaining and providing registry units; sets of storage units). Claim 54 should be allowable over Hogan et al. for at least the same reasons as claims 48-49 and 53, which are discussed above.

Claim 55

Claim 55 should be allowable over Hogan et al. for at least the same reasons as claim 54, from which it depends.

Claim 58

Claim 58 includes the limitations:

associating trading partners with said machine readable specifications

This claim is not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claim.

Neither trading partners nor the machine readable specifications are present in Hogan, arranged in the manner claimed.

Therefore, claim 58 should be allowable over Hogan et al.

Claims 59-75

Claims 59 and 65 are independent device claims that include the limitations:

[59] a network interface;

memory storing data and programs of instructions, including a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners; and

a data processor coupled to the memory and the network interface which executes programs of instructions; wherein the programs of instructions include

logic to provide, in response to a request received at the network interface, one or more of the machine-readable specifications from said registry via a communication network to a requesting node

[65] a network interface;

memory storing data and programs of instructions, including a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners, wherein the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units; and

a data processor coupled to the memory and the network interface which executes programs of instructions; wherein the programs of instructions

include

logic to provide, in response to a request received at the network interface, one or more of the machine-readable specifications from said registry via a communication network to a requesting node;

wherein the storage units comprise parsed data, and the parsed data in at least one of the documents to be exchanged comprises:

character data encoding text characters in the one of the input and output documents, and

markup data identifying sets of storage units according to the logical structure of the one of the input and output documents

These claims are not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claims.

The Examiner generally relies on his rejections of claims 48-53 and 57-58, which are incorporated by reference. We have already responded to these bases for rejection and urge that they should be withdrawn for the reasons given above.

In rejecting claim 65, the Examiner further relies on the repeatedly cited passages from columns 8, 10 and 13 for the elements of character data encoding text characters and markup data identifying sets of storage units. The additional limitations in claim 65 read on XML, which is not mentioned in Hogan, because Hogan's application was filed almost two years before the release of the XML language recommendation. Mentions of the markup language HTML within Hogan are not arranged or combined with the remaining claim elements in the same way as in the claim. The passages in columns 8 (distributed repositories), 10 (hierarchically arranged group of repositories), and 13 (search template) do not read on "character data encoding text characters in the one of the input and output documents, and markup data identifying sets of storage units according to the logical structure of the one of the input and output documents", as those elements relate to the remainder of claim 65.

Applicants respectfully submit that independent claims 59 and 65 should be allowable over Hogan et al.

Claim 70

Claim 70 is and additional independent method claims that includes the limitations:

[70] publishing through a communication network a machine-readable

specification of an interface to an operation, the specification including a definition of an input document and a definition of an output document, the definitions of the input and output documents comprising respective descriptions of sets of storage units and logical structures for the sets of storage units;

receiving data comprising an input document through the communication network;

parsing the data according to the specification to identify the input document;

providing at least a portion of the input document in a machine-readable format to a transaction process which produces an output;

forming an output document, based on the specification and according to the definition of the output document; and

transmitting the output document through the communication network

This claim is not anticipated by Hogan et al., because the reference does not include all of the same elements arranged or combined in the same way as the claim.

This claim includes **bold faced elements** of processing an input document received in conformance with a published interface specification and transmitting a responsive output document. The Examiner has missed the **new features** of the receiving, parsing, providing, forming and transmitting elements that were not in any of the prior claims. The <u>Examiner has not mentioned the new receiving, parsing, providing, forming and transmitting limitations</u> (OA at 13) and therefore has not made out a *prima facie* case.

When the Examiner compares the added limitations of this claim to Hogan, it will be apparent that the claim should be allowed over Hogan.

<u>Claims 60-69 and 71- 75</u>

Claims 60-69 and 71-75 are independent device claims with limitations familiar from the discussions above. These claims should be allowable, when combined with the claimes from which they depend, for at least the reasons described above, when the limitations were first discussed. Overall, Hogan does not include the limitations of these dependent claims arranged or combined with the remaining claim elements in the same way as the claim.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,

Dated: October 28, 2008   _____/Ernest J. Beffel, Jr./_____
                                      Ernest J. Beffel, Jr.
                                      Registration No. 43,489

Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263